

### **REMARKS**

Applicant wishes to thank the examiner for the helpful discussions during the telephone conference call of July 11, 2006.

Claims 1, 7, 13, 17, 32 and 44 have been amended to more particularly claim the embodiments of the present invention. No new matter has been added. Claim 31 has been canceled.

#### **Claim Rejections – 35 U.S.C. 102 (b)**

Claims 1-19, 23-33, 36-39 and 44-45 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,877,513 to Scarberry. Applicant respectfully traverses these rejections for the reasons now following.

Applicant wishes to bring to the Examiner's attention that claims 6 and 11 were previously canceled and claim 31 has been canceled herein and as such applicant will not be addressing the Examiner's rejections to those claims.

Dealing first with claims 1-5, independent claim 1 has now been amended to more particularly claim an embodiment of the present invention, namely, a tongue retention device consisting essentially of a single flange, an aperture formed through the flange and a protrusion covering the aperture. Scarberry does not disclose a tongue retention device consisting essentially of only those elements as claimed in claim 1 for the reasons now following.

Examiner equates body 12 of Scarberry to the single flange of claim 1. Body 12, however, further comprises respective lower and upper dentition receiving trays 22 and 20 (column 5, lines 14-15). Such additional structural limitation is more particularly shown in figures 1-4. Thus, the Scarberry intraoral appliance is retained in a user's oral cavity by lower and upper dentition receiving trays that function as a bite block. Hence, the Scarberry device requires additional structural elements in order to function properly, *i.e.*, be properly positioned in a user's mouth. The embodiment as claimed in claim 1 of the present application does not require lower and upper trays to perform its function as a tongue retention device.

In summary, it is respectfully submitted that Scarberry does not disclose or suggest a device for retaining a tongue as claimed in claim 1 and in fact teaches away from a device as claimed in claim 1. As such, it is respectfully submitted that claim 1 and dependent claims 2-5 are not anticipated by this prior reference.

Turning next to claims 7-10, 12, 15, and 16, independent claim 7 has now been amended to more particularly claim an embodiment of the present invention, namely, a tongue retention device having, among other structural elements, a single flange being substantially flexible. It is respectfully submitted that Scarberry does not disclose a single flange being substantially flexible for the reasons now following.

With reference to the embodiment in figures 1-4 of Scarberry, Scarberry discloses an intraoral appliance 10 comprising a formed body 12 (which, as stated above, the examiner equates to a single flange). Body 12 is described as a unitary, generally rigid structure or, in the alternative, an assembly of structural elements bonded together to form body 12 (column 5, lines 1-10). This is consistent with it acting as a bite block for positioning the device in a person's mouth. Even if the flange of 12 is interpreted as reference number 24, as further suggested by the examiner, element 24 is recited as being forming, *i.e.*, made of an impression forming material "to cause the material to be cast or set to the shape of the user's dentition" [emphasis added] (column 5, lines 29-31) and thus not flexible. However, in the embodiment as claimed in claim 7 of the present application the single flange is substantially flexible so that it can be comfortably received between a person's lips and frontal surface of a person's teeth or alveolar ridges if teeth are absent, to position the device.

For all the reasons stated above, Scarberry does not disclose a tongue retention device comprising a single flange being substantially flexible as claimed in claim 7. As the Scarberry reference does not disclose all of the elements of claim 7, it is respectfully submitted that claim 7 and dependent claims 8-10, 12, 15, and 16 are not anticipated by this prior reference.

With respect to claims 13-14, applicant's independent claim 13 has now been amended to more particularly claim an embodiment of the present invention, namely, a method of retaining a tongue in a predetermined position comprising, among other steps, positioning the flange between a user's lips and frontal surface of said user's teeth such that the tongue retention device does not extend substantially past the user's teeth and into the user's oral cavity. It is respectfully

submitted that Scarberry does not disclose a method as claimed in claim 13 for the reasons now following.

As previously discussed, Scarberry discloses a device having two receiving trays 20 and 22, which function as a bite block for receiving the user's upper and lower dentition. More particularly, these receiving trays each have dentition impressions 26 for receiving the user's teeth, which can be more clearly seen in Figure 3. Thus, when a user's teeth are received in the dentition impressions 26, it is clear that a portion of the Scarberry device does extend substantially past the user's teeth and into the user's oral cavity.

As the Scarberry reference does not disclose all of the elements of claim 13, it is respectfully submitted that claim 13 and dependent claim 14 are not anticipated by this prior reference.

With respect to claims 17-19 and 23-30, independent claim 17 has been amended to more particularly claim an embodiment of the present invention, namely, a tongue retention device that when the device is properly positioned, it does not extend substantially past the user's teeth and into the user's oral cavity.

It is respectfully submitted that Scarberry does not disclose a device as claimed in claim 17 for all the reasons stated above for claim 13. Thus, claim 17, and dependent claims 19 and 23-30 are not anticipated by this prior reference.

With respect to claims 32-33 and 36-39, independent claim 32 has been amended to more particularly claim an embodiment of the present invention, namely, a tongue retention device consisting essentially of a single flange, an aperture and a protrusion that covers the aperture. For all the reasons stated above for claim 1, Scarberry does not disclose a tongue retention device consisting essentially of these elements. It is respectfully submitted that claim 32 and dependent claims 33 and 36-39 are not anticipated by this prior reference.

With respect to claims 44-45, independent claim 44 has been amended to more particularly claim an embodiment of the present invention, namely, a kit comprising a tongue retention device consisting essentially of a bulb and a single flange extending therefrom. For all the reasons stated above for claim 1, Scarberry does not disclose a tongue retention device

consisting essentially of these elements. It is respectfully submitted that claim 44 and dependent claim 45 are not anticipated by this prior reference.

**Claim Rejections – 35 U.S.C. 103(a)**

Claims 21-22, 34-35 and 44-45 were rejected under 35 U.S.C. 103(a) as being unpatentable over Scarberry. Applicant respectfully traverses these rejections for the reasons now following.

Claims 21 and 22 are dependent on independent claim 17, which claim now recites a tongue retention device that when the device is properly positioned, it does not extend substantially past the user's teeth and into the user's oral cavity. For all the reasons stated above, Scarberry does not disclose a tongue retention device that does not extend substantially past the user's teeth and into the user's oral cavity as claimed in claim 17. Thus, Scarberry does not "disclose in figures 1-4 a device for maintaining a user's tongue, substantially as claimed". Neither does Scarberry suggest such a device, and, more particularly, such a device having a defined thickness or a constant thickness across the device's entire cross-section. Thus, it would not be obvious to the skilled artisan to make a tongue retention device as claimed in claims 22 and 22 in view of Scarberry.

Claims 34-35 are dependant upon independent claim 32, which now recites a tongue retention device consisting essentially of a single flange, an aperture and a protrusion that covers the aperture. For all the reasons stated above for claim 1, Scarberry does not disclose a tongue retention device consisting essentially of these elements as claimed in claim 32. Thus, Scarberry does not "disclose in figures 1-4 a device for maintaining a user's tongue, substantially as claimed". Neither does Scarberry suggest such a device, and, more particularly, such a device having a defined thickness. Thus, it would not be obvious to the skilled artisan to make a tongue retention device as claimed in claims 34-35 in view of Scarberry.

Finally, with respect to claims 44-45, independent claim 44 now recites a kit comprising a tongue retention device consisting essentially of a bulb and a single flange extending therefrom. For all the reasons stated above for claim 1, Scarberry does not disclose a tongue retention device consisting essentially of these elements. Thus, Scarberry does not "disclose in figures 1-4 a device for maintaining a user's tongue, substantially as claimed". Neither does

Scarberry suggest such a device, and, more particularly, such a device included in a kit with instructions on how to adjust the size of such a flange. Thus, it would not be obvious to the skilled artisan to make a kit comprising tongue retention device and instructions on how to adjust the flange of such device, as claimed in claims 44-45, in view of Scarberry.

In view of the arguments presented by applicant herein, applicant submits that claims 1-5, 7-10, 12-30, 32-39, 44 and 45 are in condition for allowance and such allowance is respectfully requested.

Respectfully submitted,



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Dated: \_\_\_\_\_

July 27, 2006

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